

REMARKS:

Claims 1-11 are pending and stand rejected.

Claim 1 has been amended to remove reference to preferred embodiments, and new claims 12 - 14 were added to capture these preferred embodiments.

Terminal Disclaimer and current 35 U.S.C. Rejection based on Foreign Equivalent of the US Patent for which a Terminal Disclaimer was presented.

Applicant contends that the Examiner improperly cited the foreign equivalent of a US patent that was terminally disclaimed in the present case, as a 35 U.S.C. §103 (a) prior art reference.

A Terminal Disclaimer based on the US 6,528,587 reference, in compliance with 37 CFR 1.321(c), was accepted by the USPTO, and the double patenting rejection in this was extinguished.

The Examiner is now citing EP 1136536 against the present application. EP 1136536 is the European equivalent patent to US 6,528,587 (and in fact the Examiner is using US 6,528,587 as the translation of EP1136536). The EP 1136536 reference was filed on March 16, 2001, and was published September 26, 2001, in French, based on French priority application FR 0003797 with a priority date of March 24, 2000. US 6,528,587 was filed on March 26, 2001 (which was the first business day after the one-year date of the filing of FR 0003797) and prior to any publication.

The Examiner's citation of a foreign equivalent filed only 1 year prior to the filing of a US case for which a Terminal Disclaimer has been offered and accepted is contrary to US patent policy, and in effect creates new law. Under the Examiner's reasoning, Terminal Disclaimers will no longer be available over cases filed more than 18 months before the current application filing - as a foreign publication will exist (if the case was foreign filed). If a terminal disclaimer over the US patent is not also a terminal disclaimer over all foreign equivalent cases having the same priority date, then the terminal disclaimer ceases to function in the manner anticipated in the law.

The main function of the Terminal Disclaimer is that it obviates the primary objection to double patenting, which is the extension of monopoly. In re Robeson, 331 F.2d 610, 141 USPQ

485 (1964). The Terminal Disclaimer accepted in the present application serves this function. There are many statements of the advantages of the Terminal Disclaimer to public policy, as improvements are placed into the public domain. In this regard, the framers of the present regulations placed no limits on length of time that can be terminally disclaimed.

Since the effect of a terminal disclaimer is to tie the affected patents together [*Ortho Pharmaceutical Corp v. Smith*, 959 F.2d 936, 22 USPQ 2d 1119, 1123 (Fed. Cir 1992)], then the tying of the present application to US 6,528,587 by terminal disclaimer necessarily also ties the present application to all foreign equivalent applications of US 6,528,587 having the same priority – and therefore none of the foreign equivalents can properly be cited as prior art under 35 U.S.C. §103.

35 U.S.C 103

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robert et al (European Patent No 1136536 – using US 6,528,587 as a translation). As stated above, Applicant has filed a terminal disclaimer, which was accepted by the Examiner, over US 6,528,587, which makes the citation of the European equivalent patent as art and action against US patent practice policy, and therefore invalid.

Additionally, the linking of the present application to US 6,528,587, claiming priority to FR 00 0397 filed March 24, 2000, means that a person skilled in the art could not have known the subject matter as a whole, as said subject matter had not been published – as it was identical to, and known only to the parent company and it's inventors.

It is noted that the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quadrant Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." MPEP 804.02 II

As the Examiner has pointed out, there are many similarities between the present invention and the cited art, having a common inventor. Indeed, the present invention is a selection invention that has been found to no longer present the olfactory problems of the art (page 2, lines 13-19 of the Substitute Specification), and exhibits a significant adhesiveness.

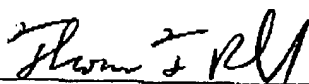
While the '587 reference lists in col. 4, line 34 that layer B can be a metallocene PE, it is listed with many other types of polyethylenes, and there are no examples using the metallocene PE. Since use of a metallocene PE over other types of PE for improved adhesiveness was not recognized in the '587 as a result effective variable, it's use could not be optimized by routine experimentation - since only result-effective variables can be optimized. MPEP 2144.03.

It was discovered by Applicant that coextrusion ties using a metallocene polyethylene as the layer B provided better adhesion than other compositions within the scope of the '587 reference. As clearly seen in the examples of the present invention, such as in comparative examples 4 and 5 which would fall within the scope of the '587 patent, the use of metallocene PE produces superior adhesive properties.

Further, the '587 patent teaches away from the present claims by exemplifying only B layers of LLDPE with a 1-butene comonomer - which are outside of the scope of Applicant's claims, and which are shown to have less adhesion than the claimed compositions.

In view of the above, the Applicant believes that the reasons for rejection have been overcome, and the claims herein should be allowable to the Applicant. Accordingly, reconsideration and allowance are requested.

Respectfully submitted;



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Date: 10/25/05